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43/Reply
Brief

Attorney Docket No.: 58569-P001US-10007125
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Rodney L. Dockery, et al.

Application No.: 08/813,852

Filed: March 7, 1997

Group Art Unit: 3627

Examiner: F. Bartuska

For: SYSTEM AND METHOD FOR PROMOTING STORES AND PRODUCTS

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GROUP 3600

APPELLANT'S REPLY BRIEF

Attention: Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, DC 20231

Dear Sir:

REPLY TO EXAMINER'S ANSWER UNDER 37 CFR 1.193(B)

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BOARD OF PATENT APPEALS
AND INTERFERENCES

This Reply Brief is in response to the Examiner's Answer mailed October 21, 2002 and is in furtherance of the Notice of Appeal, dated June 19, 2002 and received by the United States Patent Office on June 24, 2002, and Appellant's Brief, dated August 15, 2002 and received by the United States Patent Office on August 20, 2002.

Appellant respectfully requests withdrawal of the final rejection, re-opening of prosecution, and allowance of the above-captioned application. Should the Appellee not find the comments contained herein persuasive, acknowledgment of receipt and entry of this Reply Brief is requested.

INTRODUCTION

Appellant responds herein to the rejection under 35 U.S.C. § 103. Based on a review of the Examiner's Answer mailed October 21, 2002, and in particular, new points raised for the first time in the Examiner's Answer, it appears that the rejection under 35 U.S.C. § 103 is based on a misapplication of the requirement for a nexus between the evidence of commercial

success and the claimed invention and a misapplication of the requirements for establishing a *prima facie* case of obviousness.

For the reasons set forth below, Appellant requests the Board of Patent Appeals and Interferences (the “Board”) reverse the Appellee’s rejections in the event that the rejections are not withdrawn prior to reaching the Board.

Evidence of Commercial Success

In concluding that an appropriate nexus between Appellant’s evidence of commercial success and the claimed invention is not present, Appellee asserts that “it is clear from the Declaration, Supplemental Declaration and letters that Dockery House Publishing is providing more services than just those of the claimed invention,” Examiner’s Answer at page 4. The Appellee asserts that “the declaration must show that the commercial success is due to the claimed invention and not any other services or activities,” *Id.* at page 7. However, this is not the law.

Appellant is charged with the burden of establishing a *prima facie* case of the requisite nexus between the evidence of commercial success and the claimed invention, see *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 7 U.S.P.Q.2d 1222, 1226 (Fed. Cir. 1988). However, establishing a *prima facie* case of the requisite nexus does not require Appellant to show that the commercial success of the invention is not due to factors other than the invention, but rather it is up to the Appellee to “adduce evidence to show that the commercial success was due to extraneous factors other than the patented invention,” *Id.* at 1226-27. Appellee’s requirement that Appellant show that the commercial success is due to the claimed invention and not any other services or activities impermissibly seeks to shift Appellee’s burden of coming forward with evidence in rebuttal to Appellant’s *prima facie* case with respect to the requisite nexus.

Appellant has met his initial burden of establishing a *prima facie* case of the requisite nexus between the evidence of commercial success and the claimed invention. Specifically, “[a] *prima facie* case of nexus is generally made out when the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent,” *Id.* at 1226.

With respect to showing that there is commercial success, the Declaration of Caleb J. Pirtle, submitted March 28, 2002, provides at paragraph 5 thereof that “Dockery¹House was unable to penetrate the approximately \$100 million promotional magazine market with sales of conventional promotional programs which included the use of conventional promotional magazines.” However, “[a]fter making available promotional magazine programs implementing the Dockery House invention, Dockery House was successful in obtaining approximately 5% of the nearly \$100 million promotional magazine market by October 2001,” Declaration of Caleb J. Pirtle at paragraph 8. Clearly, obtaining such a relatively large share of a mature and well established market is evidence of commercial success.

Indeed, the letters attached to both the Declaration of Caleb J. Pirtle and the Supplemental Declaration of Caleb J. Pirtle, submitted April 1, 2002, support Dockery House’s commercial success in displacing conventional promotional programs with those implementing the Dockery House invention. For example, the letter from Jeff Stone of Lifestyle Vacation Incentives expressly states “we have decided to utilize Dockery House Publishing technique over the traditional promotional magazines we have used in the past.” Similarly, the letter from Roger King of FirstUp Inc. states “we are delighted to announce that Dockery House will be our publisher of choice because you are giving us something that other custom publishers wouldn’t or couldn’t do.” It is respectfully asserted that these letters, as well as the other evidence of record, support Appellant’s assertion of commercial success.

With respect to showing that the thing that is commercially successful is the invention disclosed and claimed in the patent, the Declaration of Caleb J. Pirtle at paragraphs 3 and 8 clearly sets forth that, using “the Dockery House technique of providing a magazine containing a plurality of general interest articles, wherein at least one of the articles makes reference to an identified product including specific brand information pertaining thereto, with coupons keyed to the articles containing brand specific products”, “Dockery House was successful in obtaining approximately 5% of the nearly \$100 million promotional magazine market” Clearly, the invention of claim 18, the only independent claim involved in the present appeal, is the subject of commercial success.

Supportive of Appellant’s assertion that the invention is that which is commercially successful is the fact that Dockery House was only able to successfully penetrate the promotional magazine market after introduction of the Dockery House invention, see the

Declaration of Caleb J. Pirtle at paragraphs 5-7. Moreover, the letters attached to both the Declaration of Caleb J. Pirtle and the Supplemental Declaration of Caleb J. Pirtle support the conclusion that the invention is that which is commercially successful. For example, the letter from Judy Cole of Sally Beauty Company, Inc. expressly states “[w]e believe the increased coupon redemption rate is a result of the way Dockery House Publishing provides product placement and corresponding coupons in general interest articles [and a]ccordingly, Sally will continue to purchase promotional product magazine programs from Dockery House Publishing so we can take advantage of this promotional technique.” Similarly, the letter from Jeff Stone of Lifestyle Vacation Incentives states “[w]e at Lifestyle Vacation Incentives are pleased to be moving to Dockery House Publishing promotional magazines to take advantage of the unique way in which Dockery House Publishing provides a promotional magazine in which general interest articles incorporate a product being promoted, as well as includes coupons for the promoted products corresponding to these articles.” It is respectfully asserted that the evidence of record supports Appellant’s assertion that the commercial success is of the invention as claimed.

In addressing commercial success of the invention in the Examiner’s Answer, the Appellee looks to the statements in the letters accompanying the Declaration of Caleb J. Pirtle and the Supplemental Declaration of Caleb J. Pirtle regarding coupon redemption and asserts that Appellant has not provided any showing that the Dockery House invention results in increased coupon redemption rates nor facts that increased coupon redemption rates are due to the claimed invention, see the Examiner’s Answer at pages 5 and 6. In response, Appellant asserts that whether or not an increased coupon redemption rate is experienced is not important to Appellant’s showing of commercial success of the invention.

The invention defined in the claims does not recite any aspect of coupon redemption rate. Indeed, the invention as claimed is directed toward a magazine for use in promoting the purchase of specific products. Appellant has shown how Dockery House has experienced commercial success with respect to sales of its magazines to its clients, e.g., Sally Beauty Company, Inc., Lifestyle Vacation Incentives, Consumer Solutions, and FirstUp Inc., to obtain a relatively large share of the mature and well established promotional magazine market. Although several of Dockery House’s clients have attributed higher coupon redemption rates to the use of the Dockery House inventive technique in promotional magazines, such statements are merely tangential to Appellant’s showing of record that the

Dockery House clients purchase promotional magazines from Dockery House because of their inclusion of the Dockery House invention as set forth in the claims presently on appeal. That is, Appellant has shown commercial success of the Dockery House promotional magazines incorporating the present invention, irrespective of the Dockery House client's perceived benefits associated with the use thereof.

Prima Facie Obviousness Under 35 U.S.C. § 103

Claims 18, 22, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shedd, patent number 2,215,163 (hereinafter *Shedd*), in view of Bullard, Jr., patent number 4,968,061 (hereinafter *Bullard*). Claims 19-21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shedd* in view of *Bullard* and further in view of Lamphere et al., patent number 5,127,674 (hereinafter *Lamphere*).

In response to Appellant's assertion that proper motivation to combine *Shedd* in view of *Bullard* is not present in the prior art, Appellee asserts that the disclosure in column 2, lines 27-33, of *Bullard* clearly suggests to one of ordinary skill in the art that the advertising method disclosed in *Bullard* is intended to be used in booklets, magazines, or books, see Examiner's Answer at page 8. Appellant points out that, although *Bullard* teaches that the technique for incorporating samples disclosed therein may be used in magazines, there is nothing in this disclosure to teach or suggest that the combined book and coupon unit of *Shedd* may likewise be utilized with respect to magazines. Indeed, the disclosure of *Shedd* is directed toward advertising media which is to be kept for relatively long periods of time, such as for a year or years, see e.g., *Shedd* at page 1, column 1, lines 8-10, and page 2, column 2, lines 1, lines 27-33. Accordingly, without the benefit of hindsight gleaned from Appellant's application, one of ordinary skill in the art would not have been led to the invention of the present claims from a review of *Shedd* in view of *Bullard*.

In response to Appellant's assertion that the combination of *Shedd* in view of *Bullard* do not meet the claims, the Appellee asserts that the recipes disclosed in *Shedd* are articles of general interest, see the Examiner's Answer at page 8. The Appellee further points out, in response to Appellant directing attention to the present specification for a better understanding of the recited general interest articles, that Appellant may not read into the claims features disclosed but not recited in the claims. However, Appellant does not seek to read limitations of the specification into the claims. Appellant respectfully points out that the

claims expressly recite “general interest articles”, the plane meaning of which is articles which are of general (i.e., not confined by specialization or careful limitation) interest. Appellee’s reading of recipes to meet the present claims requires ignoring the plane and accepted meaning of the recited claim language “general interest”. Appellee’s position appears to be that because a recipe may be retained for reuse, it has general interest. However, irrespective of the number of times a recipe is referred to, it remains of limited interest (cooking a particular dish) and is confined to the steps and ingredients required to prepare a particular dish. Appellant’s direction of the Board’s and the Appellee’s attention to the specification with respect to this aspect of the claim was merely to assist in understanding and appreciating the plane meaning of the words recited in the claim as the Appellee appears to be giving an unfair interpretation of those words.

With respect to Appellant pointing out that *Shedd* does not suggest including brand specific information within the recipes (relied upon by the Appellee to meet the presently claimed articles), the Appellee asserts that the disclosure of *Shedd* makes it clear that the distributor only honors the coupons of products that the distributor handles and, in order for this to be true, the brands that the distributor will honor coupons for must be identified, see the Examiner’s Answer at page 9. However, even assuming *arguendo* that the Appellee’s assertion were true, this is not sufficient to meet the claims. Including brand specific information in the coupons of *Shedd*, as asserted by Appellee, does not teach or suggest the recited brand specific information included within the article. There is nothing in the disclosure of *Shedd* to suggest including brand specific information within the recipes thereof, see e.g., page 2, column 1, lines 38-45.

In rejecting claim 19 in the Final Office Action, Appellee stated that “Lamphere et al show a promotional booklet that is specific to a particular store [and therefore i]t would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Lamphere et al to make the magazine of *Shedd*, as modified by *Bullard, Jr.*, specific to a particular store to aid shoppers in finding the advertised products,” see the Final Office Action at page 4. Accordingly, in the Appellant’s Brief, Appellant pointed out that Lamphere does not teach a magazine (or booklet) for use in promoting the purchase of specific products, but instead teaches a clutch purse type coupon-holding device. Appellant’s point is that because Lamphere is not directed to any form of publication, but instead is directed to a purse, one of ordinary skill in the art would not have been led to the present invention from a

review thereof without impermissibly using hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicants' disclosure, see M.P.E.P. § 2145(X)(A).

In response to Appellant's assertion that a *prima facie* case of obviousness has not been established with respect to claim 20 reciting "each of said articles which contains specific brand information is authored under commission by a sponsor of the specific brand in said article", the Appellee asserts that Lamphere's disclosure that advertising space may be sold to advertisers of specific stores or to advertisers of specific brands and that the writers of the advertisements are paid by the advertisers. However, even assuming *arguendo* that it is normal business practice for advertisements to be authored under commission of a sponsor of the specific brand in the advertisement, there is nothing in the prior art to teach or suggest articles including brand specific information wherein the articles are authored under commission of a sponsor of the specific brand in the article.

Appellant pointed out in the Appellant's Brief that a *prima facie* case of obviousness with respect to claim 22 has not been established because the recited limitation "the name of said specific store appears on a front cover of said magazine" remained wholly unaddressed by Appellee. Appellee now responds, after the present application is before the Board, with an attempt to establish a *prima facie* case of obviousness. In addition to the asserted rejection of claim 22 being untimely, the rejection set forth in the Examiner's Answer does not properly establish a *prima facie* case of obviousness under 35 U.S.C. § 103. *Shedd* does not disclose the name of a specific store appearing on the front cover of the book disclosed therein. Moreover, Lamphere does not teach a publication, but rather teaches a purse. Accordingly, the Appellee has not shown how the claim limitation is met by the applied art.

With respect to claim 23 reciting "the content of each of said articles which contains specific brand information is controlled at least in part by a sponsor of the specific brand in said article", the Appellee asserts that "[i]t is the examiner's position that it is well known that whoever pays the piper calls the tune," the Examiner's Answer at page 10. Following the Appellee's analogy, simply because one calls a tune does not teach or suggest that that individual also selects the notes, the key, or any other aspect of the content of the tune. Appellant respectfully asserts that Appellee has not made any statement of record sufficient

to meet the burden of establishing a *prima facie* case of obviousness with respect to the limitations of claim 23.

In responding to Appellant's assertion that Appellee has not addressed recitation of "at least one of said articles includes within its confines reference to specific brand information pertaining to products other than said identified product" in claim 25, Appellee states that "[i]t is the examiner's position that the book of *Shedd* shows plural coupons and discloses a plurality of recipes in the book [and a]ll the recipes, of course, would not include the same ingredients," the Examiner's Answer at page 10. Whether or not recipes of *Shedd* include the same ingredients or not is not determinative of the patentability of this claim. The recipes of *Shedd* must include brand specific information for a product having a coupon keyed thereto as well as brand specific information for another product. *Shedd* does not disclose brand specific information included within the recipes thereof whatsoever, see e.g., page 2, column 1, lines 21-24. Accordingly, the claim is not *prima facie* obvious.

CONCLUSION

For the extensive reasons advanced above and within the Appellant's Brief dated August 15, 2002, Appellant respectfully contends that none of claims 18-23 and 25 are obvious under 35 U.S.C. § 103 over the applied art. Therefore, affirmation of this position is courteously solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No.: EL341174300US in an envelope addressed to: Attention: Board of Patent Appeals and Interferences, Commissioner for Patents, Washington, D.C., 20231.

Date of Deposit: December 20, 2002

Typed Name: Lisa deCordova

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Respectfully submitted,

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